

Filed: October 9, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC and APPLE INC.,

Petitioner,

v.

CONTENTGUARD HOLDINGS, INC.,

Patent Owner.

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Case CBM2015-00040<sup>1</sup>  
Patent No. 7,774,280 B2

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**JOINT MOTION TO LIMIT PETITION UNDER 37 C.F.R. §42.71**

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<sup>1</sup> Case CBM2015-00160 has been joined with this proceeding.

## I. STATEMENT OF RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.71, Petitioners Google LLC (“Google”) and Apple Inc. (“Apple”), and Patent Owner ContentGuard Holdings, Inc. (“ContentGuard”), jointly request limiting the petition in covered business method review case CBM2015-00040 and case CBM2015-00160 of U.S. Patent No. 7,774,280 B2 (“the ’280 Patent”) to claims 1, 5, and 11 of the ’280 patent. The parties respectfully request that the Board remove the following claims and grounds from this proceeding:

Reference(s)	Basis	Challenged Claims
	§ 101	1, 5, 11, 12, and 22
Stefik <sup>2</sup> (U.S. Patent No. 5,634,012, issued May 27, 1997 (Ex.1002))	§ 102(b)	12 and 22
Stefik and the knowledge of one of ordinary skill in the art	§ 103(a)	12 and 22

## II. STATEMENT OF FACTS

On June 21, 2016, the Board issued a Final Written Decision in accordance with 35 U.S.C. § 328(a) and 37 C.F.R. § 42.73, in which the Board determined that

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<sup>2</sup> For clarity and ease of reference, the parties only list the first named inventor.

the '280 patent is a covered business method patent eligible for review. Paper 34. Google and Apple appealed the Board's grant of ContentGuard's Motion to Amend to the U.S. Court of Appeals for the Federal Circuit. Papers 35, 36. ContentGuard cross-appealed the Board's determination that the '280 patent is a covered business method patent eligible for review. Paper 37. On July 11, 2018, the Federal Circuit remanded this case. Paper 39. The Federal Circuit's mandate issued on September 4, 2018. Paper 40. On October 1, 2018, the Board issued an order entitled Reinstitution Under SAS, Authorizing Joint Motion to Limit Petitions, and Outlining Briefing Schedule Post-Remand. Paper 41.

### **III. ARGUMENT**

#### **A. Limiting the Petition in CBM2015-00040 and CBM2015-00160 Is Appropriate**

The Board should limit the petition in CBM2015-00040 and CBM2015-00160 for at least the following reasons.

First, the Board has authorized that “the parties may file a Joint Motion to Limit the Petitions by removing the previously non-instituted claims and grounds from the trial.” Paper 41.

Second, the parties have agreed to limit this proceeding.

Third, because this proceeding as litigated through final written decision and Federal Circuit appeal has been limited to a subset of the originally requested

claims and grounds, reducing the number of claims and grounds at issue promotes efficient use of the resources of the Board and saves expense for the parties.

**B. Summary**

For the foregoing reasons, Google and Apple and ContentGuard respectfully request that the Board remove the following claims and grounds:

Reference(s)	Basis	Challenged Claims
	§ 101	1, 5, 11, 12, and 22
Stefik (U.S. Patent No. 5,634,012, issued May 27, 1997 (Ex. 1002))	§ 102(b)	12 and 22
Stefik and the knowledge of one of ordinary skill in the art	§ 103(a)	12 and 22

from this covered business method review proceeding, and limit the petition in the present covered business method review of the '280 patent to claims 1, 5, and 11 on § 102(b) and § 103(a) grounds.

Respectfully submitted,

FITCH EVEN TABIN & FLANNERY LLP

Date: October 9, 2018

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